

## **REMARKS**

Claims 1-5, 8-13, 17-20, 23-32, 35-39, 42, and 43 were presented for examination and are pending in this application. In an Office Action dated October 13, 2004, claims 1-5, 8-13, 17-20, 23-32, 35-39, 42, and 43 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

A. First Reason for Withdrawal of Rejection (Specification clearly show claimed invention)

The Examiner states that Figures 6A-6C fail to disclose the following claim limitation, which is found in each independent claim:

“displaying simultaneously a plurality of alternate symbols from the first list in a pop-up menu at an insertion location for at least one of the alternate symbols on a display of the hand-held device.” (emphasis added)

Applicants disagree. A close look at Figure 6A shows that the user has typed “Let’s go to Erik’s Deli caf”. A pop-up list of alternate symbols appears after the partial word “caf”. Applicants contend that the pop-up list clearly appears at an “insertion location” because, as shown in Fig. 6B, the symbol “é” was selected from the list and was inserted into the text at the location where the pop-up list was shown in Fig. 6A. Thus, the insertion location of Fig. 6A was the location at the end of the partial word “caf”. The alternate symbols were displayed at this location, and ultimately, a selected symbol was indeed inserted at that location.

Another example of display at an insertion location is shown in Figs. 6B and 6C. A close look at Figures 6B shows that the user has continued typing and has now typed “Let’s go to Erik’s Deli café. I feel the need for their chili. BTW, I saw that Hello Kitty wristband you mentioned. Outpost had it for ”. A pop-up list of alternate symbols appears after the word “for” (and a space character). Applicants contend that the pop-up list clearly appears at an “insertion

location” because, as shown in Fig. 6C, the symbol “¥” was selected from the list and was inserted into the text at the location where the pop-up list was shown in Fig. 6B. Thus, the insertion location of Fig. 6B was after the word “for” and a space character. The alternate symbols were displayed at this location, and ultimately, a selected symbol was indeed inserted at that location.

Applicants contend that the specification as originally filed clearly shows an example of an insertion location. The three Figures 6A-6C taken together clearly show two separate examples of insertion locations and of selected symbols from a list being inserted at those locations (i.e., “before and after shots.”) The rejection under § 112, first paragraph, should be reconsidered and withdrawn.

MPEP 706.03(c) states that a written description rejection is proper when “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” The Examiner himself clearly understands what is meant by the phrase “insertion location” since he writes “examiner assumes that it would be a location, where next character would be written to” (pages 2 and 3 of the Office Action). This is exactly correct and it is applicants’ contention that any other interpretation of this term is unreasonable. The Examiner’s suggestion that an “insertion location” could be anywhere (i.e., NOT where the symbol is eventually inserted) is not a reasonable interpretation of the claim language. The Examiner is entitled to interpret the claims as broadly as reasonably possible. Since he himself (who may or may not have been a person of ordinary skill in the art at the time the invention was made) clearly understands what the term “insertion location” means, it is improper to maintain a rejection under the written description requirement. The rejection should be withdrawn.

B. Second Reason for Withdrawal (material incorporated by reference from parent provisional also shows claimed invention)

MPEP 608.01 states:

An application as filed must be complete in itself in order to comply with 35 U.S.C. §112. Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. Ape. 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below.

"Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. §112).

In the subject application, additional support for the above-discussed definition of "insertion location" is found on, for example, pages 18 and 19 of the parent provisional application. A copy of pages 18 and 19 are attached hereto for the convenience of the Examiner. It is proper to rely on text in a U.S. Patent application that has been incorporated by reference if that document contains essential matter. Here, the subject application claims priority to parent provisional (U.S. Application Serial No. 60/297,817) and incorporates the parent provisional by reference (see page 1 of the subject specification). Pages 18 and 19 of the parent provisional contain essentially the same example as is found in Fig. 6A-6C and also contain additional explanation.

While applicants believe that that application as filed provides adequate written description of the claimed invention, they alternately contend that the provisional parent application contains additional support for the claim language. The rejection under §112 should be withdrawn for this additional reason.

### Conclusion

In sum, Applicants respectfully submit that the pending claims patentably distinguishable over the previously cited reference (including references cited, but not applied) and fully meet the requirements of 35 U.S.C. § 112. Therefore, Applicants request reconsideration and allowance of these claims.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

RESPECTFULLY SUBMITTED,

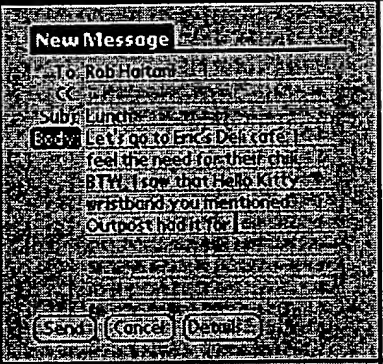
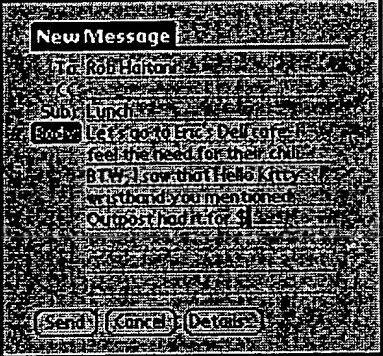
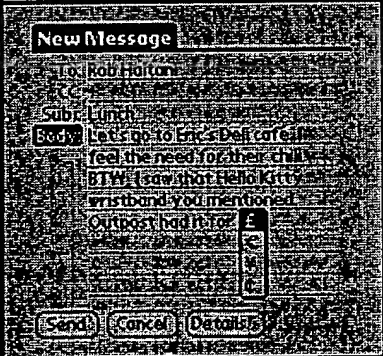

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# ATTACHMENT

	Typing Sequence	Key	Resulting Screen Shot	Notes
1	The user addresses the email, types a subject, and types some of a message. They get to a point where they need to type the final "e" in café and they want to add the accent.	Lots		
2	This is where the Type List comes in. The user starts the process by typing the base character of the list, which in this case is the character they want to accent, "e."	e		
3	The user then types the key combination to invoke Type List. Currently, the combination is slated to be Option + Space.	Option+ Space (series or parallel)		
4	The user sees that the accented character they want is highlighted. The user can select "é" and exit the Type List by typing the next character they want in the sentence, <period>.	<period>		The user could also have selected é and exited the Type List by any of the following: Return, Space, Jog Rocker In, or a direct tap on the digitizer on the desired character. Backspace cancels and returns to the base character.

In the following sequence, the user uses a Type List to type the Yen symbol, “¥”.

	Typing Sequence	Keys	Resulting Screen Shot	Notes
1	The user has reached a point in their email where they want to enter the “¥” symbol.	Lots		The character before the cursor is a <space> after “for.”
2	The user enters a “\$” which is the base character for the currency list.	Option + e (POR key for “\$”) (series or parallel)		The user knows that they want to enter an “exotic” currency symbol. They are familiar enough with Type Lists to know that the list that a certain character brings up will be related to that character, so they type a \$ hoping that exotic currency will be there. (It is.)
3	The user then types the key combination to invoke a Type List.	Option+ Space (series or parallel)		
4	The user sees that the highlighted character is not the one they want, so they scroll down the list by hitting the Down Scroll key again.	Down Scroll		The user can scroll down (and up) using the scroll buttons or the jog rocker. The user could also select the symbol they want directly by taping the screen on the symbol.

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